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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/364,638	07/30/1999	EIJI KAWAI	450127-02126	9709
20999	7590	11/01/2005		
FROMMER LAWRENCE & HAUG 745 FIFTH AVENUE- 10TH FL. NEW YORK, NY 10151			EXAMINER PEYTON, TAMMARA R	
			ART UNIT 2182	PAPER NUMBER
DATE MAILED: 11/01/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/364,638

Applicant(s)

KAWAI, EIJI

Examiner

Tammara R Peyton

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 18 August 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 45,46,48-56,58-65,67-75 and 77-79 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 45,46,48-56,58-65,67-75 and 77-79 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 45-46, 48-56, 58-65, 67-75, and 77-79 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hsu, patent number 5,785,598 and Sugimura (US 6,743,103).

As per claims 45, 51, 55, 61, 65, 67-75, and 77-79 Hsu teaches an information processing apparatus (Fig.2) comprising:

a processor (CPU, 11, Fig.2) for executing a booting program to start up said information apparatus (video game apparatus) ; and a first data store (ROM, 21, Fig.2) for storing first data, wherein said processor selectively uses said first data stored in said first data store or second data (ROM, 22, Fig. 2) stored in another data storage according to said booting program to start up said information processing apparatus, said other data storage being capable of data communication. Hsu is silent in respect to the data store being a non-removable data store. However, making integral the data

store that stores the booting program would merely be a matter of obvious. (*In re Larson*, 340 F.2d 965, 968, 144 USPQ 347, 349 (CCPA 1965))

Nonetheless, Sugimura teaches an information processing apparatus (video game apparatus) including a processor (151) for executing a booting program (in ROM 154) to start up the information processing apparatus wherein the booting program is stored in a non-removable data store. (cols. 5, lines 37-col. 16) Further, Sugimura's information processing apparatus is also able to download data from another data storage. Therefore, it would have been obvious to one of ordinary skill at the time the invention was made to implement an internal ROM into an information processing apparatus wherein the internal ROM includes a booting program to start up the information processing apparatus because both Hsu and Sugimura draws to the same conclusion of an information processing apparatus further including an operating system that carries out the booting program wherein Hsu allows another data storage to further enhance the booting process. Therein, the combination of Hsu and Sugimura would not depart from Hsu's inventive concept of having another data storage to further enhance the booting process but would add and expand the flexibility of Hsu's information processing apparatus operating system by including the ability to execute a booting program stored in an internal ROM. (Sugimura, col. 5, lines 34-65)

As per claims 46, 48, 49, 52, 54, and 58, Hsu teaches wherein the first data storage includes at least one of image data and sound data but does not expressly teach wherein the other data storage for storing said second data is a recording

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medium removably connected to said information processing apparatus also includes image and sound data. Hsu's game console (50) includes an audio outlet (via 13, Fig. 2) and a video outlet (via 15, Fig. 2) for outputting sound and image data for an inserted video game cartridge. It is well known in the art at the time the invention was made that video game cartridge's include sound and image programs that are used in accordance with a game console's audio and video outlets. Hsu teaches wherein the second data storage includes additional image programs for a video game cartridge related to the first data storage wherein the first data storage includes video game data for the related video game cartridge, therefore, one of ordinary skill in the art would readily recognize that the second data storage includes additional programs including at least one image data and sound data related to the first data storage that will be outputted via the game console's audio and video outlets.

As per claims 50, 53, 60, and 63, Hsu and Sugimura teaches wherein the other data storage is a portable electronic device.

As per claims 56, 62, and 64, Hsu teaches wherein said first and second data are image data and displaying an image of the selected image data on a display according to said booting program in starting up said information processing apparatus.

As per claim 59, Hsu teaches a method wherein an image of said first data is displayed on a display (television set, 18) in starting up said information processing

apparatus when said recording medium is not connected to said information processing apparatus, and an image of said second data is displayed on said display in starting up said information processing apparatus when said recording medium is connected to said information processing apparatus.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tammara Peyton whose telephone number is (571) 272-4157. The examiner can normally be reached between 6:30 - 4:00 from Monday to Thursday, (I am off every first Friday), and 6:30-3:00 every second Friday. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Huynh can be reached on (571) 272-4147. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300. Any inquiry of a general nature of relating to the status of this application should be directed to the Group receptionist whose telephone number is (571) 272-2100.

Mailed responses to this action should be sent to:

Commissioner of Patents and Trademarks  
Washington, D.C. 20231.

Faxes for Official/formal (After Final) communications or for informal or draft communications (please label "PROPOSED" or "DRAFT") sent to:

(571) 273-8300

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Hand-delivered responses should be brought to:

USTPO, Randolph Building, Customer Service Window

401 Dulany Street

Alexandria, VA 22314.

**TAMMARA PEYTON**  
**PRIMARY EXAMINER**

A handwritten signature in black ink, appearing to read "Tam Peyton", written in a cursive style.

Tammara Peyton

October 29, 2005